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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,828	04/26/2005	Maximilian Angel	270415US0PCT	8877
22850	7590	06/17/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MULCAHY, PETER D				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
06/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/532,828

Applicant(s)

ANGEL ET AL.

Examiner

Peter D. Mulcahy

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-15, 17, 18, 20, 21, 26-31, 34, 35, 40 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) 10-15, 17, 20, 21, 28-30, 34, 40 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 26, 27, 31, 35 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18, 26, 27, 31, 35, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih US 5,608,024 in view of Shih et al US 5,219,906.
3. The '024 patent shows terpolymers having the requisite monomers falling within the scope of the claimed amounts, see column 2 lines 15-20. It is particularly noted that the methacrylic acid is suggested as an alternative to the acrylic acid. As such, one would envisage a terpolymer having the monomeric units as claimed. The difference between this patent and the claims is the patent suggests alcohol solvents and mentions ethanol. The species of alcohol claimed, 1,2-ethanediol and 1,2-propanediol are not specifically mentioned.
4. The '906 patent has been applied to the claims and its relevance is well established. This disclosure is clearly combinable given the overlap in inventorship and similarities in the polymerization systems. The '960 patent is cited as showing the functional equivalence of ethylene glycol and ethanol. One would be motivated to use the ethylene glycol of the '906 patent as a functional equivalent of the ethanol as shown in '024. One is lead to the substitution of the solvents given the understanding that the use of ethylene glycol would provide a suitable product.

5. Claims 18, 26, 27, 31, 35 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dupis US 5,900,229.
6. The rejection set forth under 35 USC 103 in the paper mailed 2/17/09 is deemed proper and is herein repeated.
7. Applicants newly amended claims and remarks filed in support thereof have been fully considered but have been found not persuasive.
8. Applicants have amended the claims so as to require the solids content of the solution to be 25-65% by weight. It is argued that the terpolymer of Dupis is added in amounts of 0.05-10% by weight. This is not persuasive. Applicants claim language "the solution has a solids content..." taken with the transitional language "comprising" opens the claim to additional ingredients and does not limit the amount of the copolymer. The Dupis patent teaches up to 10% of cosmetic treating agent, column 11 line 49. This patent further teaches additional ingredients in an amount up to 10% at column 12 line 9.
9. These ingredients are solids and when incorporated in the amounts disclosed would render solutions having a solids content as claimed. Further, the propellant is disclosed as being used in an amount not to exceed 25%, column 12 lines 17-19. The propellant is presumed to be part of the composition and not the "solution" as it is a gas. This would further increase the relative amount of the solids in the "solution."
9. Claims 18, 26, 27, 31, 35 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al. US 6,303,189.
10. This patent teaches film forming latex polymers based upon the acrylate monomers as claimed (monomer B), see column 2 lines 13-14. This patent further

suggests the copolymerization of the acrylate monomer with vinyl pyrrolidones, see column 2 line 19. The use of the claimed solvent is exemplified at column 4 line 25. The difference between the claimed invention and the cited patent is that the examples do not incorporate the vinyl pyrrolidone monomer as claimed. The use of the vinyl pyrrolidone monomer is rendered obvious given its identification as an acceptable comonomer. It is prima facie obvious to select an ingredient from a list and have it function in an expected manner.

Rejections Withdrawn

11. The 112 new matter rejection as well as the 103 rejections over Shih et al. alone and Nakata are withdrawn in view of the remarks and claim amendments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796